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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/088,058 | 06/17/2002 | Yasuhiro Kinoshita | M 6726 PCT/US | 6717 |

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EXAMINER

ANTHONY, JOSEPH DAVID

ART UNIT PAPER NUMBER

1714

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,058

Applicant(s)

KINOSHITA ET AL.

Examiner

Joseph D. Anthony

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5-8 and 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is held by the examiner that the word "and" in line 5 of claims 5-8 and 11 should be replaced by the word —or— in order for the claims to make sense. Claim 12 is being rejected here because it is dependent on a rejected base claim.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adaniya et al. U.S. Patent Number 4,775,600.

Adaniya et al discloses highly corrosion resistant surface treated steel plates. The steel plates are coated with an aqueous resin composition comprising in part: 1) a modified epoxy resin that contains at least one basic

nitrogen atom and at least two primary hydroxy groups, 2) silica, such as fumed silica, and 3) optionally but preferably, a silane compound as the crosslinking agent for the epoxy resin and silica, see the abstract, column 5, lines 4-28, column 8, lines 58-66, column 10, lines 49-67, the examples and the claims.

Adaniya et al differ from applicant's claims invention in that there is no direct teaching (i.e. by way of an example) to where the aqueous epoxy resin composition containing fumed silica actually contains a silane.

It would have been obvious to one having ordinary skill in the art to use the disclosure of Adaniya et al as motivation to actually incorporate a silane compound into the aqueous resin compositions taught in Adaniya et al's examples, because Adaniya et al directly suggests the use of silane as a crosslinking agent for the epoxy resin used in the compositions.

5. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sujita et al. U.S. Patent Number 5,723,210 or Tsuneta et al. U.S. Patent Number 5,213,846, both patents individually in view of Adaniya et al. U.S. Patent Number 4,775,600.

Sujita et al discloses organic composite coated steel sheets. The steel sheets are coated with an aqueous composition comprising: 1) an epoxy resin, urethane resin or an acrylic resin, 2) silica particles and 3) optionally ingredients, see abstract, column 7, lines 7-25, examples and claims.

Tsuneta et al discloses corrosion resistant coating composition. The aqueous compositions comprise: 1) a bisphenol type epoxy resin, 2) silica particles, and 3) optional ingredients, see abstract, column 4, lines 9-51, examples, and claims.

Sujita et al and Tsuneta et al both differ from applicant's claimed invention in that they do not seem to disclose the further addition of a silane compound to their aqueous resin compositions.

Adaniya et al has been described above.

It would have been obvious to one having ordinary skill in the art to use the disclosure of Adaniya et al. to the use of a silane compound as an effective crosslinking agent for epoxy resin and silica containing aqueous corrosion resistant compositions, as motivation to actually add a silane compound to the aqueous corrosion resistant resin compositions disclosed by Sujita et al. and Tsuneta et al..

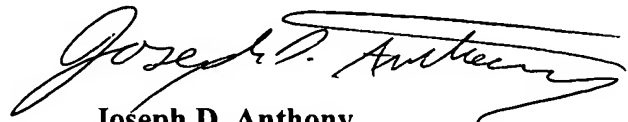
6. NOTE: Applicant's attention needs to be drawn to Shimakura et al. U.S. Patent Number 6,475,300 filed 02/27/2001. This patent is not prior-art over applicant's claims. Nevertheless, The claims of the patent are deemed to extensively overlap the subject matter of applicant's claims. As such, if applicants were to overcome the above prior-art rejections, a very real issue of an interference proceeding would need to be seriously considered. Any applicants' comments on this issue would be helpful to advance prosecution of the present application.

Prior-Art Cited But Not Applied

7. Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention.

Examiner Information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (703) 308-0446. This examiner can normally be reached on Monday through Thursday from 7:35 a.m. to 6:00 p.m. in the eastern time zone. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The group FAX machine number is (703) 872-9306. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0651. The receptionist is located on the 8th floor of Crystal Plaza 3 (e.g. CP-3) and will be the welcome point for all visitors to the building.



**Joseph D. Anthony
Primary Patent Examiner
Art Unit 1714**

9/24/03